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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,199	01/29/2001	Richard W. Simmons	13031.1USU1	9114
23552	7590	12/31/2003	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			NGUYEN, MERILYN P	
		ART UNIT		PAPER NUMBER
		2171		
DATE MAILED: 12/31/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/772,199	SIMMONS, RICHARD W.
Examiner	Art Unit	
Merilyn P Nguyen	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 29 September 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-26 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 29 January 2001 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.  
4)  Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: *Detailed Action*.

## DETAILED ACTION

1. In response to the communication dated 09/29/2003, claims 1-26 are active in this application.
2. This application claims priority to Provisional Application No. 60/179,696 filed on January 28, 2000.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-8, 10, 12-17, and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon (US 5,890,129), in view of Dyson (US 6,269,399).

Regarding claims 1 and 22, Spurgeon discloses a computer system and a method (See Figs. 2, 3 and 9) for assembling a database (See Fig. 3, 'insurer database', and col. 6, lines 42-43) regarding claimant eligibility for relief in a multiple-party proceeding (See Fig. 3, for example, 'insurer', 'first provider', 'second provider', 'nth provider' et...), the system and method comprising:

- o a client computing system ('Insurer Computer', Fig. 3) for providing access via a computer network ('Local area network', Fig. 3) for filing one or more claims for relief in the multiple-party proceeding (See Figs. 2 and 9, and col. 6, lines 24-29),

each of the claims for relief comprising first information regarding a claimant and second information regarding the claimant's eligibility for relief (See col. 6, lines 29-32); and

- a server computing system for receiving each of the claims for relief via the computer network ('Information-exchange computer', Fig. 2 or Fig. 3); and
- validating each of the claims for relief by comparing either of the first or second information against a pre-defined dataset (See col. 10, lines 19-27).

Spurgeon does not teach validating each of the claims for relief by a computer system. Dyson teaches validation processor (50, Fig. 1, Dyson et al.) utilizes a fuzzy logic system, stored procedures or an expert system to interpret and apply validation rules (Col. 3, lines 52-55, Dyson et al.). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Spurgeon system by having the expert system such as validation processor of Dyson to do the validating job. One of ordinary skill in the inventory art would have recognized that replacing people with an expert validating system would make the over all system of Spurgeon more reliable, more predictable, more accurate, and cost effective as suggested by Dyson since people might make more mistakes than a machine because of human error. Moreover, buying software to validate claims is cheaper than hiring people to do this validating job. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held

that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Regarding claims 2 and 23, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claims 1 and 22 respectively, and further discloses the pre-defined dataset includes a class list of known class members potentially eligible for relief (See col. 20, lines 25-27, Spurgeon).

Regarding claim 3, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 1 and further discloses associating a unique personal identifier with each of the claims for relief, the unique personal identifier being capable of uniquely identifying the claimant (See either ‘insured’s id number’ of Fig. 9, or ‘patient SSN’ of Fig. 7, Spurgeon).

Regarding claim 4, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 3, and further discloses associating a unique personal identifier with each of the claims for relief includes associating a reference string with each of the claims for relief (See either ‘insured id number’ of Fig. 9, or ‘patient SSN’ of Fig. 7, Spurgeon).

Regarding claim 5, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 4, and further discloses:

- providing the reference string to the claimant prior to receiving each of the claims for relief ('member number', Fig. 5, or 'insured id number', Fig. 9, Spurgeon); and
- receiving the reference string with each of the claims for relief (See Fig. 9, and col. 9, lines 54-57, Spurgeon).

Regarding claim 7, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 3, and further discloses associating a unique personal identifier with each of the claims for relief includes associating a keycode with each of the claims for relief ('patient SSN', Fig. 7, Spurgeon)<sup>1</sup>.

Regarding claim 8, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 7, and further discloses receiving the keycode with each of the claims for relief (See col. 9, lines 54-57, Spurgeon).

Regarding claim 10, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 8, and further Spurgeon states: "Once the claims processing department receives the claim, the staff verifies the member's eligibility" (See col. 10, lines 20-22, Spurgeon); here, it is understood that processing claims includes processing the keycode to determine whether the potential claimant may be eligible for relief since keycode is associated with each of the claims.

Regarding claim 12, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses providing access comprises transmitting a computer application via the computer network, the computer application being configured to receive each of the claims for relief (See col. 6, line 66 to col. 7, lines 3, Spurgeon).

Regarding claim 13, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses providing access comprises transmitting a form to a claimant via the computer network, the form being adapted for receiving each of the claims for relief (See Fig. 9, Spurgeon).

Regarding claim 14, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses processing at least one of the first and second information to determine whether the potential claimant may be eligible for relief (See col. 10, lines 19-22, Spurgeon).

Regarding claim 15, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 14, and further discloses processing at least one of the first and second information comprises defining a criterion for eligibility for relief and determining whether at least part of the second information meets the criterion (See Fig. 7, and col. 6, lines 37-38, and col. 10, lines 19-22, Spurgeon).

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<sup>1</sup> Please note that 'keycode' is unique to a member and can be a social security number as exemplified in applicant's

Regarding claim 16, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses storing third information regarding receiving the one or more claims for relief (See col. 7, lines 34-37, Spurgeon).

Regarding claim 17, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 16, and further discloses storing the third information comprises storing one selected from the group consisting of a network address from which each of the claims for relief was received (See col. 7, lines 34-37, Spurgeon), a date when the each of the claims for relief was received (See Fig. 15, and corresponding text, Spurgeon), and a time when each of the claims for relief was received is inherent since the database can be used to store all kinds of data.

Regarding claim 19, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses confirming receipt of the first and second information via the computer network (See col. 10, lines 19-25, Spurgeon).

Regarding claim 20, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses providing a distribution to eligible claimants in the multiple-party proceeding (See col. 10, lines 28-31, Spurgeon).

Regarding claim 21, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 1, and further discloses providing access to the database to at least one third party

having an interest in the multiple-party proceeding thereby allowing the at least one third party in the multiple-party proceeding to monitor the filing of each of the claims for relief (See Fig. 3, and corresponding text, Spurgeon).

Regarding claim 24, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 22, and further discloses a reference string that has been provided to claimants prior to receiving the first and second information, wherein the reference string is received in connection with the first and second information ('member number', Fig. 5, or 'insured id number', Fig. 9, and col. 9, lines 54-57, Spurgeon), and wherein the validation module processes the reference string to determine whether the claimant may be eligible for relief (See col. 10, lines 20-22, Spurgeon).

Regarding claim 25, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 22, and further discloses a keycode received in connection with the first and second information ('patient SSN', Fig. 7, Spurgeon)<sup>2</sup>, and wherein the validation module processes the keycode to determine whether the claimant may be eligible for relief (See col. 10, lines 20-22, Spurgeon).

Regarding claim 26, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 22, and further discloses the validation module processes at least one of the first

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<sup>2</sup> Please note that 'keycode' is unique to a member and can be a social security number as exemplified in applicant's specification.

and second information to determine whether the claimant may be eligible for relief (See col. 10, lines 20-22, Spurgeon).

4. Claims 6, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon (US 5,890,129), in view of Dyson (US 6,269,399), and further in view of Miller (US 5,608,784).

Regarding claim 6, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 5, however, Spurgeon/Dyson is silent as to comparing the reference string provided to the claimant against the reference string received with each of the claims for relief. On the other hand, Miller discloses comparing the reference string provided against the reference string received (See col. 5, lines 62-65, Miller et al.). Because Spurgeon system, combined with Dyson, is used to determine and validate claimant eligibility and request (See col. 10, lines 19-25, Spurgeon), it would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate the step of comparing the reference string provided to the potential claimant against the reference string received with each of the claims for relief in the combined system of Spurgeon in view of Dyson, as suggested by Miller et al. The motivation would have been enhancing authentication in order to provide relief to claimants.

Regarding claim 9, Spurgeon/Dyson/Miller discloses all the claimed subject matter, as set forth above in claim 8, and further discloses validating each of the claims for relief comprises

comparing the keycode received with each of the claims for relief against the pre-defined dataset as addressed above in claim 6.

Regarding claim 11, Spurgeon/Dyson/Miller discloses wherein validating each of the claims for relief comprises:

- comparing a reference string provided to the claimant against a reference string received with each of the claims for relief; and
- comparing a keycode received with each of the claims for relief against the pre-defined dataset as addressed above in claim 6.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon (US 5,890,129), in view of Dyson (US 6,269,399), and further in view of Ogilvie (US 6,343,738).

Regarding claim 18, Spurgeon/Dyson discloses all the claimed subject matter, as set forth above in claim 1, however Spurgeon/Dyson is silent as to receiving a digital signature uniquely identifying the source of each of the claims for relief. On the other hand, Ogilvie discloses using digital signature to authenticate information received (See col. 20, lines 31-34, Ogilvie et al.). It would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate or include digital signature in Spurgeon, as suggested by Ogilvie et al. The motivation would have been uniquely identifying which claimants sent claims for relief.

***Response to Arguments***

6. Applicant's arguments filed on 09/29/03 with respect to claims 1-26 have been fully considered but they are considered moot in view of the new grounds of rejection.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 703-305-5177. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN

MN  
December 22, 2003

LL

Uyen Le  
AU 2171